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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,255

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Yukiyoshi Hikichi

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FITZPATRICK CELLA HARPER & SCINTO

1290 Avenue of the Americas

NEW YORK, NY 10104-3800

EXAMINER

RILEY, MARCUS T

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

09/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,255	Applicant(s) HIKICHI ET AL.	
	Examiner MARCUS T. RILEY	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2625

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2010 has been entered.

Response to Amendment

2. This office action is responsive to applicant's remarks received on September 15, 2010. **Claims 1, 3, 4, 7, 9 & 10** are pending. **Claims 2, 5, 6 & 8** have been cancelled.

Response to Arguments

3. Applicant's arguments with respect to amended **claims 1, 7, 9 & 10** filed on September 15, 2010 have been fully considered but they are not persuasive.

Applicant's Arguments

For Applicant's remarks see "*Applicant Arguments/Remarks Made in an Amendment*" filed September 15, 2010.

Examiner's Response

Art Unit: 2625

Applicant argues that the applied art is not seen to disclose or suggest (i) determining a range of printable image information stored on a storage device attached to a recording medium, and (ii) printing an image based on the determined range of the image information.

Examiner understands Applicant's argument but respectfully disagrees. Petteruti at Column 4, line 33-67 and Column 3, lines 44-52 determines a range of printable image information stored on a storage device attached to a recording medium and prints an image based on the determined range of the image information. For example, the host terminal sends to the printer 10 commands and data that direct the printer controller 34 to print on media using the print mechanism 36. The controller 34 operates the RFID encoder 22 to store digital information or data, which may be related to information printed by the print head 18 upon the same part of the media having the RFID circuit. Moreover, the controller 34 specifies a range commands that are printable such as RF tag information, product name, description, weight, an id number. Thus, Petteruti discloses, teaches or suggests Applicant's invention.

The other claims in the application are each dependent from the independent claims and are also not allowable over the applied references for at least the same reasons. As a result, Applicant's application is not in condition for allowance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claim 7** is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a

Art Unit: 2625

statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101” – publicly available at USPTO.GOV, “memorandum to examining corp”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be “tied” to another statutory category, the structure of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

6. **Claim 9** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. **Claim 9** defines a computer readable storage medium program embodying functional descriptive material. However, the claim does not define a non-transitory computer-readable medium or non-transitory computer-readable memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to

Art Unit: 2625

embody the program on a “non-transitory computer-readable medium” or equivalent; assuming the specification does NOT define the computer readable medium as a “signal”, “carrier wave”, or “transmission medium” which are deemed non-statutory (refer to “note” below). Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. **Claims 1, 3, 4, 7, 9 & 10** are rejected under 35 U.S.C. 102(c) as being anticipated by Petteruti et al. (US 6,409,401 hereinafter, Petteruti ‘401).

Regarding claim 1; Petteruti ‘401 discloses an image processing apparatus (Fig. 1, Printer 10) comprising:

an input unit (Fig. 2, Host Terminal 52) which inputs image information including first image information to be printed on a recording medium (Fig. 1B, Media 16 i.e. The host terminal sends to the printer 10 commands and data that directs the printer controller 34 to print on media using the print mechanism 36. Column 4, lines 40-45);

and second image information to be stored in a storage device (Fig. 1B, RFID Circuit 16a) which is attached to the recording medium (i.e. The controller 34 operates the RFID encoder 22 to store digital

Art Unit: 2625

information or data, which may be related to information printed by the print head 18 upon the same part of the media having the RFID circuit. Column 3, lines 44-52);

a printer (Fig 1, Printer 10) which prints an image on the recording medium to which the storage device is attached wherein the image is based on the first image information (i.e. The portable printer is used for printing on media and encoding RFID circuits coupled to such media in which the information printed on the media can be related to the information encoded. Column 1, line 66 thru column 2, line 3);

a writing unit (Fig 2, RFID (Read/Write) encoder 22) which writes the second image information to the storage device attached to the recording medium (i.e. The RFID encoder 22 operates in accordance with programmed microprocessor controller 34 (FIG. 2) on the printed circuit board 24 to write data onto the RFID circuit. Column 3, lines 20-52);

a controller (Fig 2, Microprocessor Controller 34) which controls said printer (i.e. The printer control has a microprocessor controller 34 for controlling the print head 18 and actuating motor 21 to drive media 16 across the print head 18. Column 2, lines 46-67);

to print the image based on the first image information on the recording medium (i.e. The controller 34 operates the RFID encoder 22 to store digital information or data which may be printed by the print head 18 upon the same part of the media having the RFID circuit. Column 20, lines 44-52);

and controls said writing unit to write the second image information and authentication information corresponding to each of a plurality of levels to the storage device wherein a printable range of the second image information differs at each level (i.e. The RFID encoder 22 operates to write data onto the RFID circuit 16 and store digital information or data which may be printed by the print head 18. When such media represents labels to be applied to products, the information stored in the RFID circuit may represent an identifier(s) or characters defining the product, barcode or other identifying data. Column 3, lines 20-52);

a reading unit (Fig 2, RFID (read/write) encoder 22) which reads the second image information and the authentication information stored in the storage device attached to the recording medium (Fig. 3, Step 62 i.e. The RFID encoder 22 is capable of reading an RFID circuit before encoding to read information previously stored in the circuit, such as a unique address or code associated with the RFID circuit, or after encoding to verify that the RFID circuit

Art Unit: 2625

has been properly encoded with data. Using the encoder 22, the controller 34 next reads the RFID circuit to verify that the tag was encoded with the data at step 62. Column 3, lines 20-52 and Column 5, lines 4-25);

a user authentication information input unit which inputs user authentication information (i.e. The host terminal or computer sends to the printer 10 and directs the printer controller 34 to print on media using the print mechanism 36 or to encode or read an RFID circuit 16a on media 16 at step 52. The controller 34 then specifies commands, such as an id number, as and determines whether the commands and data are valid at step 54. Column 4, line 33-67);

wherein said controller determines a range of the second information which is printable in accordance with the user authentication information input by said user authentication information input unit based the authentication information read by said reading unit (i.e. The controller 34 specifies a range commands that are printable such as RF tag information, product name, description, weight, an id number and determines whether the commands and data are valid at step 54. Column 4, line 33-67).

and the user authentication information input by said user authentication information input unit, and controls said printer to print an image based on the determined range of the second image information read by said reading unit (i.e. The host terminal or computer sends to the printer 10 and directs the printer controller 34 to print on media using the print mechanism 36 or to encode or read an RFID circuit 16a on media 16 at step 52. Column 4, line 33-67).

Regarding claim 3; Petteruti '401 discloses a display unit (Fig. 2, Display Unit 28) which displays an image based on the second image information stored in the storage medium (i.e. Display unit 28 displays image information stored in the storage medium. Column 4, lines 7-32).

Regarding claim 4; Petteruti '401 discloses an instruction unit (Fig 2, Part of the Controller 34 – Not shown.) which instructs said printer to perform printing based on the content image displayed by said display unit (i.e. Fig. 2 shows where the display is coupled to input/output ports of the controller 34 wherein the controller instructs the printer to print and the information may be displayed on display #28. Column 4, lines 7-32).

Regarding claims 7, 9 & 10; Claims 7, 9 & 10 contain substantially similar features as that of claim 1. Thus, claims 7, 9 & 10 are rejected on the same ground as claim 1. Petteruti '401

Art Unit: 2625

also discloses a computer readable program, stored in a computer-readable storage medium (i.e.

Fig. 3 is a flowchart that shows the RFID encoding program (software) for the printer 10 wherein the program may be stored in memory of the controller 34, such as SRAM, FLASH, or external memory 37. Column 2, lines 4-8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus T. Riley
Assistant Examiner
Art Unit 2625

/MARCUS T. RILEY/
Examiner, Art Unit 2625

Application/Control Number: 10/827,255

Page 9

Art Unit: 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625